

**REMARKS/ARGUMENTS**

This Amendment is responsive to the Office Action mailed on November 17, 2008. In this Amendment, Claims 1 and 10 are cancelled, and Claims 2-9 and 11-20 are amended, leaving Claims 1-20 pending and subject to examination. The amendments to Claims 2, 7, 11, and 16 place them in independent form.

A number of rejections are provided in the Office Action. They are discussed in the order presented therein.

**I. Examiner Interview**

Applicants thank Examiner Lastra for the telephonic interview granted on January 6, 2009. Pursuant to M.P.E.P. §713.04, Applicants respectfully submit the following Summary of the Interview: Applicants' representative proposed amendments that would overcome the §101 rejections. It was proposed that the method claims be amended to tie the claimed methods to an apparatus by reciting steps performed by a server computer. It was also proposed that the computer readable medium claims be amended to recite "a computer readable medium comprising code executable on a computer." The Examiner appeared to agree that the proposed claim amendments overcome the §101 rejections. Applicants have amended the claims according to the amendments proposed during the Interview.

**II. Rejections under 35 U.S.C. §101**

Claims 1-20 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. *Office Action*, page 2, paragraph 4. Independent method Claims 2 and 6 have been amended to tie the claimed methods to an apparatus by reciting steps performed by a "server computer." Independent Claims 11 and 16 have been amended to recite "a computer readable medium comprising code executable on a computer." During the Interview, the Examiner appeared to agree that these amendments would overcome the 101 rejections. Applicants submit that independent Claims 2, 6, 11, and 16 and their dependent claims are proper under 35 U.S.C. §101. Applicants respectfully request withdrawal of the 101 rejections.

**III. Rejections under 35 U.S.C. §112, second paragraph**

Claims 2, 7, and 10-20 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. *Office Action*, page 3, paragraph 2.

**A. *Claims 2 and 11***

MPEP 2173.02 states:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available...The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

The Office Action alleges that the feature of “reducing or eliminating the combination reward, if a third product is purchased” is indefinite because it is not explained in the specification (Application disclosure). *Office Action*, page 3, paragraph 3. The Office Action interprets the feature as meaning that the combination reward is “not given...if the products in said combination reward are not purchased.” *Id.* Applicants traverse this rejection and disagree with the Examiner’s interpretation of this feature.

The feature of “reducing or eliminating the combination reward, if a third product is purchased” is definite because it clearly and particularly points out the subject matter of an embodiment of the invention in view of the Application disclosure at paragraph [0017] and [0054]-[0056], FIG. 6, as well as elsewhere in the disclosure. Paragraph [0017] states that “FIG. 6 shows a Venn diagram and a box indicating that a reward will be *reduced* if a certain product is purchased.” *Application*, paragraph [0017] (emphasis added). In the embodiment shown in FIG. 6, consumers receive a combination reward of an additional \$0.60 if they purchase 2 Cola Ys and

one Root Beer M and the combination reward is *nullified (eliminated)* if they purchase a *third* product, Cola Z:

[0054] FIG. 6 shows a variation on the programs illustrated in Example 1 and FIG. 5. Company S has a program C (75) that works in conjunction with program AuB (74) by providing another program 75 that provides a reward of an additional \$0.60 for only purchasing products made by Company S, and not Cola Z produced by Company T.

[0055] The application of this Boolean example can be applied to many parameters and parameter combinations (such as adding cardholder ID, card groups, programs, Issuer ID, merchant groups, SKUs,) to further segregate and personalize rewards.

[0056] The Boolean logic for these complex programs can be converted into a human readable format by translating the new program equations into simple text, which can be printed or displayed to a cardholder. This text defines the new program rules for participating in a program. For example, text that corresponds to this example may be: "[i]n order to qualify for an additional \$0.60 reward you must purchase 2 Cola Ys and one Root Beer M; but is *null* if combined with a purchase of Cola Z."

*Application*, paragraphs [0054]-[0056] (emphasis added). Claims 2 and 11 are directed to this embodiment of the invention where the combination reward is reduced/eliminated if a *third* product is purchased and the combination reward is provided based on the purchase of (at least) a *first* product and a *second* product. Contrary to the assertion made in the Office Action, the feature of "reducing or eliminating the combination reward, if a third product is purchased" is clearly explained in the Application disclosure. Therefore, Claims 2 and 11 are proper under 35 U.S.C. §112, second paragraph. For this reason, Applicants respectfully request that the rejection be withdrawn.

**B. Claims 7 and 16**

Claims 7 and 16 have been amended to more clearly and particularly point out the inventive concepts previously present in these claims, as well as to place the claims in independent form. As amended, Claims 7 and 16 recite the feature of "wherein the combination

reward is the ability to access the at least one of the first and second rewards at an earlier time than one or more times associated with the at least one of the first and second rewards.”

Claims 7 and 16 are definite because they particularly point out and distinctly claim the subject matter of an embodiment of the invention in view of the Application disclosure at paragraphs [0035] and [0063]. In paragraph [0035], the Application disclosure describes an embodiment of the invention where a combination reward is a reward based on time:

[0035] Preferably, the value of the combination reward may be greater than the value of each individual reward by any suitable amount. For example, in some embodiments, the combination reward may be 10, 20, 50, or even 100 percent greater in value than each individual reward associated with each individual reward program used to form the combination reward program. *Also, the combination reward may be the same or different type than the individual rewards. For example, the combination reward may be a reward based on time, whereas the individual rewards may be based on dollar value.*

*Application*, paragraph [0035] (emphasis added). Paragraph [0063] describes an example of a combination reward based on time that allows consumers earlier access to rewards (e.g., the first or second rewards) than those consumers that *have not satisfied* the combination reward requirements (e.g., purchasing the first product and the second product):

[0063] Embodiments of the invention may also provide for rewards that are based on time. For example, a consumer may be encouraged to buy Cola Y and receive a reward. The resulting combination reward (for the purchase of Cola Y and another predetermined product) may be that the end date for all programs will be extended for an additional 30 days. Additionally or alternatively, there can be an additional program where a loyal consumer participates in all Programs (AuB)u(1u2), where A, B, 1, and 2 all represent different programs. Preferred consumers (e.g., preferred cardholders) can access to a set of special programs 10 days earlier than consumers who *have not satisfied* the predetermined combination reward program reward triggers.

Claims 7 and 16 are directed to this embodiment of the invention where the combination reward based on time allows consumers earlier access to the first or second rewards than consumers that have not satisfied the requirements of the combination reward. For example, a consumer that purchases both the first product and the second product may be given earlier access (e.g., 10 days earlier) to the first reward associated with the first product than a consumer that has purchased the first product and not the second product. Since Claims 7 and 16 clearly and particularly points out the subject matter of an embodiment of the invention in view of the Application disclosure, these claims are proper under 35 U.S.C. §112, second paragraph and Applicants respectfully request that the rejection be withdrawn.

**C.                *Claims 10-20***

The Office Action states that Claims 10-20 are rejected as being “indefinite because they are not computer readable medium claims.” *Office Action*, page 4, paragraph 1. During the Interview, Applicants’ representative proposed amending these claims to recite a computer readable medium comprising code executable on a computer. During the Interview, the Examiner agreed that the proposed amendments to the claims would overcome the 112 rejection.

Independent Claims 11 and 16 have been amended as proposed during the Interview. Applicants submit that as amended independent Claims 11 and 16 and their dependent claims are proper under 35 U.S.C. §112 and respectfully request withdrawal of the rejection.

**IV.    Rejections under 35 U.S.C. §102**

Claims 1, 8, 9, 10, 17, and 18 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application 2003/0212626 to Vulkan ("*Vulkan*").

Independent Claims 1 and 10 have been canceled and thus the rejection with respect to these claims has been rendered moot. Claims 8, 9, 17, and 18 have been amended to depend from Claims 2 and 11, which are not rejected under 35 U.S.C. §102(e). Thus, the 102 rejections with respect to Claims 8, 9, 17, and 18 are also rendered moot. Applicants respectfully request that the 102 rejections be withdrawn.

## **II. Rejections under 35 U.S.C. §103(a)**

### **A. *Claims 2-5 and 11-14***

Claims 2-5 and 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vulkan* in view of Official Notice. The rejection is traversed.

#### *Official Notice*

MPEP 2144.03 states:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known.

The Office Action takes Official Notice that several features of Claims 2-6 and 11-15 are old and well-known. *Office Action*, page 6, paragraph 2 - page 7, paragraph 2.

Pursuant to MPEP 2144.03, *Applicants challenge the Examiner's taking of Official Notice in each and every instance that this is done in this Office Action and in future Office Actions*. Applicants respectfully submit that the features recited in Claims 2-6 and 11-15 are not common knowledge and are not instantly and unquestionably demonstrable as being well-known. For example, the features of Claim 2 include a combination reward program that provides a combination reward that is based on the purchase of at least the first product and the second product, wherein the combination reward is greater than each of the first reward and the second reward, and reducing or eliminating the combination reward, if a third product is purchased. These features of Claim 2 are not common knowledge and certainly not instantly and unquestionably demonstrable as being well-known. MPEP 2144.03.

Applicants request that the Examiner find a prior art reference to support any allegations that these features in Claims 2-6 and 11-15 are "well known." If such features are in fact "well known" in the art, then it should not be too burdensome for the Examiner to find and

cite such references. Even if the Examiner can find a reference teaching these features, the reference may not be combinable with *Vulkan* or may teach away from the combination.

Claims 2 and 11

The Office Action alleges that the feature of “reducing or eliminating the combination reward, if a third product is purchased,” as recited in independent Claims 2 and 11 is not explained in the Specification. *Office Action*, Page 3, paragraph 3. The Office Action interprets the feature to mean that “if the products in a package deal are not purchased, said package deal is not honor[ed].” *Id.* The Office Action states that *Vulcan* does not teach this element, as interpreted by the Examiner, and takes Official Notice that the element, as interpreted by the Examiner, is “well known in the promotion art.” *Office Action*, page 6, paragraph 2.

As discussed in Section III above, the feature of “reducing or eliminating the combination reward, if a third product is purchased,” is clearly explained in the Application disclosure at paragraph [0017] and [0054]-[0056], and FIG. 6 as well as other portions of the disclosure. The claimed feature is directed to an embodiment of the invention where the combination reward is provided based on the purchase of a *first* product and a *second* product. The combination reward is reduced or eliminated if a *third* product is purchased.

Applicants submit that *Vulcan* does not teach or suggest the feature of “reducing or eliminating the combination reward, if a third product is purchased,” as recited in Claims 2 and 11 in view of Application disclosure at paragraph [0017] and [0054]-[0056], and FIG. 6. *Vulcan* describes a system that generates cross promotional deals to promote products. *Vulcan*, paragraph [0184]. *Vulcan* does not describe reducing or eliminating a cross promotional deal if a third product is purchased.

For these reasons, independent Claims 2 and 11 and their respective dependent Claims 3-5, and 12-14 are allowable. Applicants respectfully request withdrawal of the obviousness rejection.

**B.                *Claims 6 and 15***

Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vulkan* in view of U.S. 2005/0055272 to Ryan (“*Ryan*”). Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vulkan* in view of U.S. 2003/0212626 to Gauthier (“*Gauthier*”). The rejection is traversed. Claims 6 and 15 are allowable because they depend on non-obvious Claims 2 and 11. Applicants respectfully request withdrawal of the obviousness rejection.

**C.                *Claims 7, 16, 19, and 20***

Claims 7, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Vulkan* in view of U.S. 2003/0212626 to Gauthier (“*Gauthier*”). The rejection is traversed.

The cited references fail to teach or suggest the feature of “wherein the combination reward is the ability to access the at least one of the first and second rewards at an earlier time than one or more times associated with the at least one of the first and second rewards,” as recited in Claims 7 and 16, as amended. Claims 7 and 16 are directed to an embodiment of the invention where the combination reward is a reward based on time that allows consumers earlier access to their first or second rewards than consumers that have not satisfied the requirements of the combination reward including purchasing the first and second products.

*Gauthier* describes a layered instant win program where different merchants are involved. *Gauthier*, paragraph [0071]. A consumer may win X if they purchase one movie ticket at any theater and may win Y if they purchase two movie tickets at two different theaters. *Id.* However, *Gauthier* does not describe that the instant win program gives the consumer access to the prize X at an earlier time than it would have been awarded had the second ticket not been purchased. Thus, *Gauthier* fails to teach or suggest the feature of “wherein the combination reward is the ability to access the at least one of the first and second rewards at an earlier time than one or more times associated with the at least one of the first and second rewards,” as recited in Claims 7 and 16, as amended.



*Vulkan* describes a cross promotion method of bundling products and offering the bundled products at a price X. *Vulkan*, paragraph 17. *Vulcan* does not describe offering any reward at an earlier time.

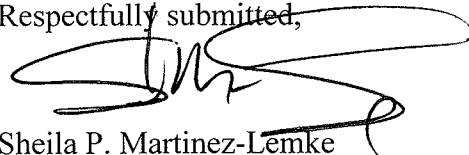
Claims 7 and 16 are allowable because neither of the cited references teach or suggest the feature of "wherein the combination reward is the ability to access the at least one of the first and second rewards at an earlier time than one or more times associated with the at least one of the first and second rewards," as recited in amended Claims 7 and 16. Claims 19 and 20 are allowable because they depend on non-obvious Claims 2 and 11. For these reasons, Applicants respectfully request withdrawal of the obviousness rejection.

**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Sheila P. Martinez-Lemke  
Reg. No. 52,004

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 415-576-0200  
Fax: 415-576-0300  
Attachment  
SML:rgy  
61851828 v1